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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,413	09/26/2003	Paola Franceschini	01023US01	8421

7590 11/27/2006

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/672,413

Applicant(s)

FRANCESCHINI, PAOLA

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 11 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): the 112 rejections of 21-23.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-10 and 21-23.
Claim(s) withdrawn from consideration: None.

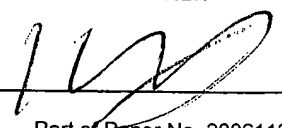
AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

**KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER**



Continuation of 11. does NOT place the application in condition for allowance because: See final rejection.

Applicant claims that "the viscosity of the mixture in the reaction medium of Kan Cao is lower than 5 cps", however, nowhere is this found to be taught in Kan Cao et al. Applicant's statements appear to be conclusory with no evidence to support them.

Applicant also argues that "[the] addition of hydrophilic comonomer causes poor stability and decreases flexibility of polymerization conditions." However applicant's claim 1 requires the addition/presence of a hydrophilic functional monomer.

Thus, the hydrophilic monomer is not excluded from the present claims

Applicant further argues that "[t]here is no anticipation of the limitation of at least 7 cps at 40C in Kun Cao", however this limitation is not required by the present claims.

Finally, applicant argues that "the author of the article [Kun Cao et al.] tested a percentage of comonomer (AA or MAA) not higher than 10 % relative to the MMA and that, starting from a proportion of AA and MAA of about 5%, the particle size distribution had an abrupt increase." However, this limitations is not recited in the present claims (see claim 1). These arguments are not persuasive.

Regarding Sekmakas and Goldberg, the fact that these references do not explicitly state viscosities is not alone evidence that they do not meet the viscosity requirements. (see 102/103 rejections) All of the claimed structural components used in the claims are present in each of the references.

As with Kun Cao, the content of hydrophilic monomer lower than 10% is not excluded from the present claims, even if it were required by the prior art, which it is not.

Applicant further argues that "Goldberg patent teaches and claims the possibility of preparing a co-polymer of Vinyl acetate and N-methylolacrylamide by emulsion polymerization. This means starting from a monomer emulsion obtained through the use of a suitable emulsifier (in this case an appropriate hydrolysis degree PVA is used) [and that] ... This step is different from what that claimed." However, this is not different from what is presently claimed. The claims require a polymerization stabilizer, which include protective colloids such as Hydrolyzed PVA.

Applicant also argues that "[t]he amount of N-methylolacrylamide that can be introduced with the process described in Goldberg (e.g., claim 2) is, however, limited from 1 to 16%; opposite the amounts in the claimed process". However, again, no such opposite limitations are found in the independent claim.

Applicant argues that the pre reaction viscosity in Goldberg is very high and that "[i]n the experimentation described in the present application, viscosity up to 42 cps at most are reported." However, again, this limitation is not found in the independent claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

While Goldberg et al., Sekmakas or Kun Cao et al. may not expressly teach the determination of pre-reaction viscosities measured at 40°C of the reaction mixtures, it is reasonable that the pre-reaction viscosities of Goldberg et al., Sekmakas or Kun Cao et al. would be essentially the same as in the claimed process since the components of the prior art reaction mixtures are essentially be the same as in the presently claimed process and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old process is not patentable regardless of any new or unexpected properties. In *re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive process because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.